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IN THE

Supreme Court of the United States.

OCTOBER TERM, 1930.

No. [redacted]3

THE PERMUTIT COMPANY,
Petitioner,

vs.

GRAVER CORPORATION,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI.

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GUNTHORP-WARREN PRINTING COMPANY, CHICAGO.

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THE PERMUTIT COMPANY,

Petitioner,

vs.

GRAVER CORPORATION,

Respondent.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Petitioner brought suit against Respondent in the United States District Court at Chicago, Illinois, for alleged infringement of Claims 1 and 5 of the Gans Patent No. 1,195,923, for Apparatus for Softening Water. (R. 584.) The application for said patent was filed August 5, 1911, and the patent granted thereon August 22, 1916.

Said Claims 1 and 5 read as follows:

"1. A water softening apparatus comprising a casing, a filter bed consisting of a layer of sand or quartz and a layer of zeolites or hydrated alumino-silicates disposed on the layer of sand or quartz, means for permitting the passage of water through the casing, means for cutting off the supply of water on the exhaustion of the zeolites, and means for passing through the casing a solution of a salt capable of regenerating the zeolites.

5. Water softening apparatus comprising a casing, a filter bed consisting of a layer of zeolites or alumino-silicates, supporting means for said layer, means for permitting the passage of water through

> the casing, means for cutting off the supply of water on the exhaustion of the zeolites, means for supplying and passing into the casing a solution of a salt capable of regenerating zeolites and means connected to the lowest point of the casing for removing the salt solution so introduced."

The trial judge, Walter C. Lindley, held said claims invalid for want of invention (R. 555, 570) 37 Fed. (2nd) 385. The Seventh Circuit Court of Appeals on October 20, 1930, affirmed said decision, and additionally held that Respondent's "presently used structures" (upflow water softeners) do not infringe Claim 5 (R. 679, 689.)

Petitioner does not dispute non-infringement of Claim 1 by Respondent's "presently used structures," said Claim 1, by disclaimer (R. 587), being limited to downflow water softeners.

This Court, in Rule 38 as amended, states under Part 5:

> "A review on writ of certiorari is not a matter of right, but of sound judicial discretion, and will be granted only where there are special and important reasons therefor. The following, while neither controlling nor fully measuring the Court's discretion, indicate the character of reasons which will be considered:
>
> * * * * *
>
> (b) Where a Circuit Court of Appeals has rendered a decision in conflict with the decision of another Circuit Court of Appeals on the same matter; * * *"

Respondent will show that there is no conflict *on the same matter* between the decisions of the Courts of Appeals for the Second and Sixth Circuits on the one part, and the Court of Appeals for the Seventh Circuit on the other part, for the reason that the evidence in the Seventh Circuit case is new and different in many ma-

terial respects, notwithstanding Petitioner's inaccurate and groundless statements to the contrary.

On this point, the Court's attention is directed to its decision handed down January 26, 1931, and reported in the January 27, 1931, issue of The United States Daily, as follows:

> "No. 50. The Wisconsin Electric Company, petitioner, vs. The Dunmore Company. On writ of certiorari to the United States Circuit Court of Appeals for the Sixth Circuit. *Per curiam:* It appearing that the asserted conflict in decisions arises from differences in states of fact, and not in the application of a principle of law, the writ of certiorari is dismissed as improvidently granted."

Such is exactly the situation in the instant case and it is submitted that consideration of same should result in a denial of the petition.

Among these material differences, which later will be considered more in detail, are the following:

1. *The Rundschau Water Softening Apparatus (Respondent's physical Exhibit No. 19), was not in evidence in the cases before the Second and Sixth Circuit Courts of Appeals.*

This is an upflow water softener.

Judge Lindley, with this new evidence and supporting testimony, held:

> "The evidence in the instant case is conclusive to the effect that upward flow softeners are in fact of greater utility and efficiency than downward flow softeners." (R. 562) 37 Fed. (2nd) 385, 389.

The attitude of the Courts of Appeals for the Second and Sixth Circuits, with different evidence or lack of evidence before them, is specifically expressed in the opinion of the Sixth Circuit Court of Appeals as follows (13 Fed. (2nd) 454, at 456):

"Nor does it follow that in this particular envi-

ronment there is no patentable distinction between the downflow and the upflow. The former works satisfactorily, and it seems probable, if not certain, that the latter would not."

The Circuit Court of Appeals for the Seventh Circuit, through Judge Evans, in its opinion stated (R. 684):

> "In the instant suit the advantages or disadvantages of an apparatus calling for a downflow of water through the zeolites were sharply contested. The District Judge found, contrary to the observations of the court in the last cited case, 'the evidence in the instant case is conclusive to the effect that upward flow softeners are in fact of greater utility and efficiency than downward flow softeners.'
>
> An examination of the evidence not only substantiates the finding of the District Court but persuasively supports it. In view of the object to be accomplished, it would seem difficult, if not impossible, to say there was either merit or novelty in providing means which call for the downflow rather than the upflow of water through the bed of zeolites. * * *"

2. *Gans Article of April* 15, 1909 (R. 517): *Petitioner's Translation Thereof* (R. 450); *Respondent's Translation thereof.* (R. 351.)

Certain testimony of Mr Waterman, Petitioner's patent expert in the instant case but not in the other cases, supports Respondent's contention that said Gans Article is a complete anticipation of the claims in isssue, including the feature of the free and unconfined zeolite bed (R. 70), Petitioner's patent expert Waterman stating:

> "Where Gans mentioned any place back-washing, my same definition obtained, that is, that the bed of zeolites is free and unconfined."

3. *Petitioner's Letter of March* 18, 1920, *by its technical expert, Thos. R. Duggan, to Dr. Charles F. McKenna (Respondent's Exhibit No.* 62) (R. 546), *was not in evidence in the other cases.* (Filter Art.)

Said letter discusses the water softening and water filtering art, and reads in part as follows:

> "The process is a very simple one as you will notice by the literature which we enclose. It is nothing more or less than a filter, but the bed, instead of being sand or some other mineral, is a zeolite which is manufactured in our factory in Brooklyn."

4. *Commercial Success.*

Testimony in the case at bar but not in the other cases shows that Petitioner's commercial success resulted from the mineral zeolite, sand filters, limestone water softeners, carbon dioxide recording instruments for use in combustion work, a continuous blow-off system for boiler plants, and manganese removal systems, in addition to zeolite water softeners. (R. 23 and 89.)

5. *Weiss Thesis* (R. 521); *Drawings Thereof* (R. 524) *and Translation Thereof* (R. 525), *is new evidence in this case.*

Respondent will show, as trial Judge Lindley stated in holding Claims 1 and 5 invalid in the instant case:

> "• • • Having the greatest respect for those courts, I have taken great care in my examination of the prior art and of the evidence here presented in order to determine whether my convictions in the contrary direction are proper. *To me it seems manifest that had this situation been as fully presented to the various courts before whom there has heretofore been litigation as here, there could have been but one conclusion."* (R. 566.) (Emphasis ours.)

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1. *The Rundschau Water Softening Apparatus* (*Respondent's Physical Exhibit No.* 19).

This exhibit and supporting evidence were not before the Second and Sixth Circuit Courts of Appeals.

It is true that the Rundschau Article (Respondent's Exhibit No. 24, (R. 461), Translation thereof, Respondent's Exhibit No. 25 (R. 465), was only briefly referred to by Judge Hand (then a District Judge in the Second Circuit) in his opinion on the first motion for preliminary injunction, and was ignored by the other courts, as stated by Petitioner's patent expert, Edwin W. Hammer, in his affidavit in support of Petitioner's motion for preliminary injunction in this case. None of said courts appreciated the anticipatory value of said Rundschau Article of January 27, 1909, and because said Article illustrated and described an upflow water softener and the softeners complained of (except in the *Paige-Jones case,* 292 Fed. 239) were downflow softeners, said Rundschau Article was discarded.

The Sixth Circuit Court of Appeals correctly expressed the attitudes of the Second and Sixth Circuit Courts with respect to upflow water softeners, when it stated in *Permutit* v. *Wadham et al.* 13 Fed. (2nd) 454, at 456:

> "One point now stressed is in regard to plaintiff's disclaimer. Under the language of the claim as issued, the flow of water through the zeolites might have been either upward or downward. Early in the litigation a German publication* was produced which was claimed to disclose the same process, but which showed the water passing upwardly. The drawings and description in the patent in suit showed that the water flowed downwardly, and Gans became convinced, even if he did not at first appreciate, that the downward flow, as distinguished from the upward, was practically essential to a com-

*Feldhoff Article on [illegible], 1897. Respondent's Exhibit No. 32 (R. 477). Translation thereof. Respondent's Exhibit No. 33 (R. 479).

> mercially successful process. He therefore disclaimed so much of the patent as might reach a process employing the upward flow, and thereby, in effect, amended and limited his claim to a device employing downward flow."

Then on page 457, Judge Denison, speaking for the Sixth Circuit Court of Appeals, stated:

> "Nor does it follow that in this particular environment there is no patentable distinction between the downflow and the upflow. *The former works satisfactorily, and it seems probable, if not certain, that the latter would not.* The reasons why one will and the other will not show that this difference is one of those which are not so simple as they seem." (Emphasis ours.)

That is the reason why the Rundschau Article, disclosing an upflow water softener, was given no consideration by the Second and Sixth Circuit Courts of Appeals.

On the contrary, Judge Lindley, the trial judge in the Seventh Circuit, in considering the Sixth Circuit Court of Appeals' decision, stated:

> "* * * Obviously the Court was of the opinion, drawn from the evidence before it, that the upward flow softener would not work and that, therefore, the reference to an upward flow softener was not pertinent. *The evidence in the instant case is conclusive to the effect that upward flow softeners are in fact of greater utility and efficiency than downward flow softeners."* (R. 562.) (Emphasis ours.)

As a matter of fact, Petitioner's own experienced witness, Mr. Paige, admitted the same (R. 156) when he said:

> "That is an up-flow type of water-softener, and I consider that to be a very successful type of water-softener. I consider it to be a better type than the downflow."

This finding of fact of Judge Lindley, re-enforced by

the finding of the Seventh Circuit Court of Appeals, will not be disturbed by this Court. On this same point, Judge Evans, speaking for the Seventh Circuit Court of Appeals, stated:

> "In the instant suit the advantages or disadvantages of an apparatus calling for a down flow of water through the zeolites were sharply contested. The District Judge found, contrary to the observations of the Court in the last cited case, 'the evidence in the instant case is conclusive to the effect that upward flow softeners are in fact of greater utility and efficiency than down flow softeners.'
>
> An examination of the evidence not only sustains the finding of the District Court but persuasively supports it. In view of the object to be accomplished, it would seem difficult, if not impossible, to say there was either merit or novelty in providing means which called for the down flow rather than the up flow of water through the bed of zeolites. The finding of the District Court, however, conclusively eliminates this asserted novelty (b) which resides in an apparatus which provides for the *down flow* of the water through the zeolites.
>
> Confronted with a problem of providing means for the introduction of water into a casing at the bottom of which was a layer of gravel upon which rested a layer of zeolites, and through which the water was to pass, the mechanics had the choice of running the water upward or downward. As no new results attended the flowing of the water either way, it merely called for the exercise of discretion on the part of the mechanic to place the opening either at the top or at the bottom of the casing." (R. 684.)

The new evidence in the instant case with respect to the commercial operativeness of the upflow water softener disclosed in the Rundschau Article took the form of a full sized device built in accordance with the Rundschau Article, the trial Judge Walter C. Lindley finding that:

> "* * * Defendant built a softener in accordance

with its understanding of this article and operated the same at the Hawthorne Laundry. Plaintiff's (Petitioner's) experts admitted that the operation was successful, the only dispute being as to whether or not in the structure made by defendant (Respondent), the bed of excelsior was located and confined in the same manner as indicated in the Rundschau article. After considering all of the evidence the court is of the opinion that the construction in question was in substantial accordance with the disclosure of the Rundschau article." (Rec., 565.)

Based upon this new and material evidence, the Seventh Circuit Courts, for one of their reasons, held the claims in issue invalid for want of invention. It was because of lack of evidence in the other suits that the Courts of Appeals for the Second and Sixth Circuits made erroneous findings of fact, and therefore erroneous conclusions of law that the claims in issue were valid.

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2. *Gans Article of April* 15, 1909. (R. 517.)

Petitioner's own translation of this Article reads as follows (R. 450):

"In the technique of water purification.

The permitits appear particularly suitable for the softening of water and the removal of manganese (or iron) therefrom.[3].

(a) *Softening:*

The process in question in this connection is in its simplest form a pure exchange process, by means of which the calcium and magnesium of the water are taken up by the zeolite and sodium is given off to the water:

$2S10_2$. Al_2O_3. $Na_2O+CaH_2(CO_3)2$
$=2SiO_2$. Al_2O_3. $CaO+Na_2H_2(CO_3)2$.
$2SiO_2$. Al_2O_3. $Na_2O+CaSO_4=2SiO_2$. Al_2O_3.
$CaO+Na_2SO_4$.

[3]R. Gans, Verbesserung von Trink — und Gebrauchswasser, etc., Mitteilungen a. d. Kgl. Prüfungsandstalt für Wasserversorgung und Abwässerbeseitigung, Berlin, 1907, no. 8.

"The regeneration is accomplished by washing with a solution of common salt the zeolite that is saturated with calcium or magnesium, in consequence of which process there is again formed a sodium zeolite which takes charge of the softening of new quantities of water. Various filters of this kind are already in use, partly for the production of soft water for boiler supply purposes, partly for laundries.

The filter plants in question are notable for the simplicity of their arrangement.

The softening is complete even in the case of cold water.

The equipment consists of an iron or wooden filter. The depth of the permutit layer is determined according to the degree of hardness of the water in question and the speed of filtration. The efficiency is the greater, the more slowly the water flows through the permutit filter and the finer the grains of the permutit are.

The permutit layer rests upon fine sand which grows coarser toward the bottom. *In the upward direction it is best terminated by a sand filter, which applied to a depth of about* 1/3 *to* 1/2 *meter over the surface of the permutit layer.* The sand filter is more suitably replaced, under various circumstances, by a limestone filter, in the case of ferriferous or acid waters, for example. This arrangement of the upper sand or limestone filter is further intended to prevent the permutits, which have a lower specific gravity, from being mechanically washed away in case of back washes.

Example: In a Berlin factory there is a plant for the softening, 10 hours each day, of 35 to 40 cubic meters of boiler supply water of about 10 German degrees of hardness. For this purpose 2 filters are built in each of 2.4 meters height and 1.2 meters diameter. Each filter contains about 700 kilograms of centrifugally dried (450 to 500 kilograms of air dried) permutit in a layer about 70 centimeters deep. There is always only one filter in operation. Within the first 4 to 5 days the filter supplies water of 0 degrees of hardness, after which the hardness gradually rises until the 7th day, reaching 4.5 to 5 degrees of hardness. It is thereupon regenerated.

with a solution of 150 to 180 kilograms of common salt, denatured with charcoal, in 900 to 1000 kilograms of warm water, which solution is caused to flow slowly over the filter. Finally the filter is rinsed out until the disappearance of the chlorine reaction, whereupon it is ready for further use."

The only sentence of this Article on which Petitioner's and Respondent's translators disagree is italicized above above and is as follows (R. 517) in the German text:

"* * * Nach oben hin wird sie am besten von einen Sandfilter abgeschlossen, das in zirka 1/3 bis 1/2 m Höhe über die Oberflaeche der Permutitschicht angebracht ist."

Petitioner's translation of said sentence is as follows (R. 450):

"In the upward direction it is best terminated by a sand filter, which is applied to a depth of about 1/3 to 1/2 meter over the surface of the permutit layer."

Respondent's translation is as follows (R. 351):

"At the top it is best closed off by a sand filter placed about 1/3 to 1/2 meter above the surface of the Permutit layer."

Petitioner's contention is that the sentence in question means that the sand filter is placed down tight on the top of the permutit bed, and that therefore the zeolite bed is not unconfined at the top.

Respondent's contention is that the zeolite bed has free space thereabove amounting from one-third to one-half a meter. Any unprejudiced German translator, it is submitted, will translate the German sentence in question as Respondent has. But, in any event, there is *new* evidence in the case at bar showing conclusively that the Gans Article clearly describes a zeolite bed which is free and unconfined, if the specification of the Gans patent in suit can be construed to describe a free and unconfined zeolite bed.

Petitioner's patent expert, Mr. Waterman, in endeavoring to establish that the Gans patent in suit describes a free and unconfined zeolite bed, testified as follows (R. 70):

> "* * * Where Gans mentioned any place *back-washing,* my same definition obtained, that is, that the bed of zeolite is free and unconfined." (Emphasis ours.)

Petitioner's own translation of the Gans Article reads in part as follows (R. 450):

> "* * * This arrangement of the upper sand or limestone filter is further intended to prevent the permutits, which have a lower specific gravity, from being mechanically washed away in case of *back washes.*" (Emphasis ours.)

Therefore, if *back-wash* in the specification of the Gans patent in suit means a free and unconfined zeolite bed, by the same token *back-wash* in the anticipatory Gans Article of April 15, 1909, means a zeolite bed which is free and unconfined. Certainly the Gans Article otherwise describes everything forming the subject matter of the controversy. Petitioner agrees therewith, or at least does not controvert the fact.

To this fact apparently the Sixth Circuit Court of Appeals agrees with respect to the German publications. See its opinion, 13 Fed. (2nd) 454, at 458:

> "It is true under the construction which we give the patent, and in order to sustain the patentable novelty of the device, the claim must be limited so as to involve the use of a zeolite bed which is free and unconfined upon the top, and the specification does not expressly state this limitation, nor does the exact language of the claim compel it"

Further, Petitioner's president, Mr Kriegsheim, testified (R. 184) that Gans disclosed to him the idea of the zeolite water softener with a "free and unconfined bed" in the middle of April, 1908. Such being the case, Mr.

Gans, a year later, when he published his Article of April 15, 1909, was describing what he considered to be a successful zeolite water softener with a free and unconfined bed, as distinguished from a locked bed which Gans is now credited as believing was an inoperative softener.

It is also significant that Gans in the last paragraph of his Article of April 15, 1909, refers to exactly the same installation referred to in the earlier Technische Rundschau Article of January 27, 1909 (R. 461, translation R. 465). Gans in this Article is talking about successful devices and their simplicity, and their production of zero hardness water, and proper regeneration of zeolites, and back-washing, and everything that is mentioned or can be inferred from the Gans patent in suit. This Gans Article of April 15, 1909, especially with its new significance in this suit, is a complete anticipation of any invention Gans alleges to have made and as defined in Claims 1 and 5 of his patent. In this connection, see Judge Lindley's opinion (R. 559):

> "Appreciating that the proper translation is a question of fact, I am of the opinion, after a careful perusal of all of the direct and cross-examination of the translators that defendant's translation is more nearly consistent with the original meaning of the German words used than that of the plaintiff. The cross-examination of the translators who testified for plaintiff weakens the force of their direct testimony. I am of the opinion that at that time, in 1909, Gans was describing a body of zeolites which was free and unconfined."

The Seventh Circuit Court of Appeals on this same subject stated (R. 685):

> "Some dispute has arisen over the translation of a Gans article written in the German language. In a study of the various translations and in the differences that arise over them it is significant that Gans himself did not testify or explain or attempt

> to explain what appellee asserts was fatal to his right to a patent in the United States. He also failed to explain why he did not apply for a patent in Germany on the apparatus here under consideration. Gans was evidently an inventor who knew the value of patents and the record shows he secured several of them in the United States. His failure to secure one in Germany suggests, at least, that he was perhaps embarrassed by this prior art."

It is significant indeed that Gans did not file an application in Germany for a patent corresponding to the one in issue. It is perfectly apparent that Gans realized the German Government knew of the anticipatory German publications but correctly assumed that such German publications would not be known by the United States Patent Office

3. *Petitioner's Letter of March* 18, 1920, *By its Technical Expert, Thos. R. Duggan, to Dr. Charles F. McKenna* (*Respondent's Exhibit No.* 62) (R. 546), *was not in evidence in the other cases.* (*Filter Art.*)

Petitioner, at page 11 in its brief, states:

> "The filter patents (R. 560-630) do not negative invention in the Gans patent for they do not disclose a recognition of the problems involved in the design of a zeolite water softener and not one of them could be used as a water softener without complete reorganization."

There is *new evidence* in this case to show that quite the contrary is true. Attention is directed to a letter dated March 18, 1920, (Respondent's Exhibit No. 62, R. 546) from the Petitioner, by Thos. R. Duggan, technical manager, to Dr. Charles F. McKenna, in which Petitiner in part states, with respect to petitioner's zeolite water softeners:

> "The process is a very simple one as you will notice by the literature which we enclose. It is nothing more or less than a filter but the bed, instead of being sand or some other material, is a

zeolite which is manufactured in our factory in Brooklyn."

In this connection, see Judge Lindley's findings and conclusions (R. 569) as follows:

"I am of the opinion further that the patent office was right in its conclusion that in substance the claims are merely reproductions of structures found in the prior art that in such filters as those in Jewel No. 478,261, July 5, 1892, Bachman No. 678,532, July 16, 1901 and Driesbach No. 630,870, we find apparently a free and unconfined bed, the elements injected into these claims by the Court of Appeals for the Sixth and Second Circuits in order to validate the same. Remembering the comments of the patent office upon the Bommarius patents, observing that the defendant at the present time manufactures sand filters of the same structure as zeolite softeners, it seems claim that there was no invention in either claim because of the substitution of zeolites. Duggen, technical manager of the plaintiff, in March 1920 wrote a letter, in which he said: 'The process is a very simple one as you will notice by the literature which we enclose. It is nothing more or less than a filter, but the bed, instead of being sand or some other material, is a zeolite which is manufactured in our factory in Brooklyn.'

True it is that the process of softening involves a chemical change as the water passes through the zeolites, where as the purification of water through sand involves only the removal of physical impurities, yet the mere substitution of the zeolites for sand is not invention, in view of the fact that zeolites themselves were previously patented by Gans. (No. 943,535, reissues thereof No. 13,688 and No. 960,887). He undoubtedly accomplished invention in these patents, but when he merely adapted the sand filter construction to the use of zeolites by substituting the latter for sand he did not accomplish invention. The art of filtering and that of softening, if not identical, are surely analogous. (*Jay* v. *Weinberg, et al.*, 262 Fed. 973. ____ C. C. A. 7.)"

On this same point, the Seventh Circuit Court of Appeals stated (R. 687):

> "• • • Other prior art citations were the Bommarius patents Nos. 519,565 and 632,091, each covering a 'filter' and each describing an apparatus for filtering water for drinking and other purposes. While neither contemplated the use of zeolites both covered apparatuses for use where water passed through a filtering bed, obviously a kindred art."

---

4. *Commercial Success.*

There is new evidence in the case at bar clearly to indicate that Petitioner has no right to argue commercial exploitation and success.

The mere fact that Petitioner by its very first witness, Mr. Tiger, attempted to emphasize alleged commercial success of the zeolite water softener by the Petitioner, shows that there is doubt, even in Petitioner's mind, as to the validity of the claims in issue, for it is only when there is doubt that such testimony is material.

Mr. Tiger, in direct examination, obviously intended that the trial court should believe, and most certainly led Respondent to believe, that the alleged enormous business done by the Petitioner in 1928 was the direct result of the manufacture and sale of the zeolite type of water softener. (R. 23.) However, upon cross-examination (R. 89), it was established through Mr. Tiger that the alleged enormous business included not only the water softening apparatus but also the sale of mineral zeolites; also sand filters; also lime soda water softeners; also carbon dioxide recording and indicating instruments for use in combustion work, and also manganese removal systems.

Accordingly, Petitioner's original testimony on the commercial success was nothing short of deceptive, and

the Petitioner made no effort of its own initiative to correct the deception. Furthermore, Petitioner has not attempted to bring out in this record just how much business it has done in the zeolite water softener department. Therefore, its testimony amounts to nothing in so far as establishing commercial success, and the court accordingly is bound to disregard the question of commercial success in this case, although it was given controlling importance by the Courts in the other cases; 279 Fed. 713; 13 Fed. (2nd) 454.

The Seventh Circuit Court of Appeals on this subject stated as follows (R. 690):

> "Extensive use has also been stressed by counsel as a reason for upholding the patent. That there has been an extensive use of zeolites for water softening purposes must be admitted. Such use strongly evidenced outstanding merit in this mineral compound for water softening purposes. We are not, however, impressed with the argument that the extensive use is attributable to the apparatus for holding and regenerating the zeolites. The art was advanced by the discovery of the product—zeolite in natural and artificial form—and in the discovery of the water softening qualities of this product, supplemented by the further discovery that such article could be regenerated readily and cheaply. Gans obtained a patent in this country on zeolites and the process for making them. If this patent were assailed and doubt existed as to its validity, the extensive use relied on, would strongly support the patent. But we cannot ascribe this extensive use to both the commodity and to the apparatus for its use, when convinced that its actuating cause is to be found in the article only."

5. *Weiss Thesis.*

The Weiss Thesis of June 3, 1910 (Respondent's Exhibit No. 60, R. 521-524, translation thereof, R. 525) is an entirely new defense in the case at bar.

By stipulation (Respondent's Exhibit No. 59), it was agreed that the Weiss Thesis (Respondent's Exhibit No. 60), known as "Das Mangan Im Grundwasser," was published in printed form on June 3, 1910. Therefore, while this Thesis is not a publication more than two years prior to the filing date of the Gans application, nevertheless, said Weiss Thesis, published as of June 3, 1910, is a reference, because it is earlier than any date established by Petitioner of its introduction of the invention in question into this country.

Referring first to "Anlage 2," or the sheet of drawings No. 2 (R. 523), of the Weiss Thesis (Respondent's Exhibit No. 60), it will be noted that the water softener there disclosed includes a casing, near the lower end of which there is a mechanical filter 0.20 of a meter high, a bed of zeolites 0.70 of a meter high and then at a distance of 0.50 of a meter above the upper surface of the zeolite bed is another mechanical filter 0.25 of a meter high and there is a stirring device extending into the upper portion of the zeolite bed all as shown in the drawings of the Gans patent in suit. This reference was cited primarily to show that a free and unconfined zeolite bed, or a zeolite bed with free space above it, was old and clearly disclosed both by the drawings and by description in this Weiss Thesis. This apparatus, according to the Thesis (see the translation, Respondent's Exhibit No. 61 (R. 525), page 12 thereof), was tested out at the City Water Works in the City of Glogau, Germany, first on October 20, 1908, and then from January 15th to February 2, 1909.

It is true that this device at Glogau was used primarily for purifying water of iron and manganese by filtering same through calcium aluminate silicate, as indicated on pages 8 and 11 of the translation. However,

on page 8 of the translation, under item number 2, as one of the possibilities of the device, it is also stated:

> "To take away the full hardness from a hard water, or part thereof, by passing same through a filter of sodium aluminate silicate, whereby at the same time also iron, manganese, and ammonia are extracted from the water."

Referring now particularly to page 11 of the translation (R. 534), attention is directed to the paragraph which reads as follows:

> "For the carrying out of the demanganizing experiments the firm David Grove, Berlin, which had also executed the other new installations for the waterworks, had set up a round boiler, about 2 meter high and with a bottom surface of about .95 of a square meter, and in this boiler the filtering installation was placed. As will be seen from the attached drawing, there is placed in the bottom of the boiler a bottom of a woven fabric which carries a gravel layer 20 centimeter high. On this gravel layer is placed the zeolite filter, properly speaking to a height of about 70 centimeter, containing about 450 kiligram calcium zeolites, and above the latter, at a distance of 50 centimeter, there is double layer of a fabric which has a layer of marble pieces between the two layers of fabric. This lime filter serves for the purpose of, first, bringing about the possibly required deacidifying of the water, and on the other hand, to prevent the washing away of the permutite in case of uncautious backflushing."

This Weiss Thesis therefore is a complete anticipation not only of any alleged invention set forth in Claim 1, but also of Claim 5, if the latter is held infringed, because the exit pipe in the drawing of the Thesis is as close to the lowest point of the casing as is defendant's pipe in its upflow softener.

As a side issue, but nevertheless an interesting one, in connection with the description which has just been quoted hereinabove, attention is directed again to the

Gans Article of April 15, 1909 (Respondent's Exhibit No. 47), and more particularly to the translation thereof (Respondent's Exhibit No. 44), and again more particularly to the translation made by Petitioner's translator (R. 451), in which, under the heading "(b) Removal of Manganese or of Iron," the following statement is quoted:

> "At Glogau, for the purpose of removing manganese, 450 kilograms of calcium zeolites, which rested in an iron tank of 0.95 square meter cross sectional area in a layer of about 0.6 meter deep, were converted according to process III, example 2, first into manganese zeolites by washing with manganese chloride solution, and then back to calcium zeolites by means of calcium permanganate solution."

It is significant that Gans, in his Article of April 15, 1909, therefore was referring to this very 1908 installation in Glogau having the free and unconfined bed and about which Mr. Weiss tells us in his Thesis of June 3, 1910. (Respondent's Exhibit No. 60.) Judge Lindley so found (37 Fed. (2nd) 385, at 391, R. 565.)

New Evidence.

From a discussion under the five preceding headings, it is evident that the record in the instant case is different in many material respects from the records presented on the other appeals, and it was directly because of such *new evidence* that Judge Lindley stated (R. 566):

> "* * * To me it seems manifest that had this situation been as fully presented to the various courts before whom there has heretofore been litigation as here, there could have been but one conclusion."

CLAIMS IN ISSUE CLEARLY INVALID.

The Second Circuit Court of Appeals in *Permutit* v. *Harvey*, 279 Fed. 713, and the Sixth Circuit Court of Appeals in *Permutit* v. *Wadham*, 13 Fed. (2nd) 454, injected an element into Claims 1 and 5 for the purpose of sustaining said claims. For example, Judge Denison, in speaking for the Sixth Circuit Court of Appeals, at page 458, stated:

> "It is true that under the construction which we give the patent, and in order to sustain the patentable novelty of the device, the claim must be limited so as to involve the use of a zeolite bed which is free and unconfined upon the top, and that the specification does not expressly state this limitation, nor does the exact language of the claim compel it."

The Second and Sixth Circuit Courts of Appeals seized upon this point because it was so strongly emphasized by Petitioner's patent experts. Petitioner's patent expert, Mr. Hammer, in the Paige & Jones case (R. 73) stated:

> "Once Gans had shown that the way to make a successful zeolite softener was to leave the bed free and unconfined, the arrangement of the pipes so that the water would run one way or another is nothing but a plumber's job."

In the first place, such statement is an admission by Petitioner that there is no invention in a downflow softener over an upflow softener, or vice versa, which, in effect, means that when Gans disclaimed with respect to the upflow in Claim 1, as a matter of fact, he disclaimed the whole alleged invention in Claim 1.

In the second place, such statement shows that Petitioner's own experts admit that if Gans made any invention, it was in providing free space above the bed of zeolites. Petitioner's patent expert, Mr. Hammer, in the Paige & Jones case, again stated:

"As I understand it, the important discovery

> made by Gans, and the feature of construction which differentiates the Gans apparatus from unsuccessful apparatus prior to him, is the free and unconfined bed to which I have referred, and which prevents the accumulation of dirt and slime in the bed."

If that was Gans' important discovery and his important contribution to the art, why didn't he make some statement of that important feature in the specification? Why didn't he make some statement in the claims about that all-important discovery?

Judge Denison, speaking for the Sixth Circuit Court of Appeals, in an endeavor to justify sustaining Claims 1 and 5 by injecting the "free and unconfined bed" element into them, states (13 Fed. (2nd) 454, at 458):

> "The specification and drawing provide for the occasional descent into the zeolite bed from above of a revolving stirrer, and this makes it clear that the top of the zeolite must be free and unconfined, under the contemplation of these claims, 1 and 5, which do not imply the nonuse of the stirrer."

It is peculiarly significant that the Gans specification does not say a single word about, nor do the drawings provide for, "the occasional descent into the zeolite bed from above of a revolving stirrer."

A mere inspection of Figure 2 of the drawings (R. 584) will show that it would be impossible to raise the stirrer from the position shown, because the shaft *y* and its gear *u* would prevent it.

Judge Denison then goes on to state:

> "Limitations upon a claim may not be imported from an ambiguous specification into an unambiguous claim for the sake of saving the validity of a patent,"

referring to *McCarty* v. *Lehigh*, 160 U. S. 110, 116. However, Judge Denison found in this patent a structure which in fact does not exist there and cannot thus func-

tion in the way which he mentions, and upon that error imports into the claims a feature not expressed nor implied in the specification.

In that same case of *McCarty* v. *Lehigh Railroad Company,* in discussing importing a feature into a claim, among other things, this Court stated:

> "The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim and avoid a defense of anticipation, we shall never know where to stop. * * * This doctrine is too obviously untenable to require argument."

It is obvious from the above that Claims 1 and 5 of the Gans patent are clearly invalid, and it is submitted that this Court, consistent with its earlier decisions, would so hold, if the case were heard. For this reason alone the petition should be denied.

Conclusion.

It is well established by this Court that where the essential rights of the parties are not affected, there is no ground upon which the Court should exercise its discretionary power in issuing a writ of certiorari. In *Smith* v. *Vulcan Iron Works,* 165 U. S. 518, at 526, this Court stated:

> "Had the case been heard anew in each court after the first mandate, the only difference in the result would have been an affirmance, instead of a dismissal, upon the second appeal. That difference, not affecting the essential rights of the parties, is no ground upon which this court should exercise its discretionary power of issuing a writ of certiorari."

In view of the concurrent findings of fact of the trial court and the Seventh Circuit Court of Appeals in this case, it is submitted that no reason exists why the general rule should not apply—that concurrent decisions of

two lower courts on an issue of fact will be accepted by this Court unless shown to be erroneous (*The Wildcroft,* 201 U. S. 378, 387; *The Carib Prince,* 170 U. S. 655, 658).

As stated by this Court in *Keller* v. *Adams-Campbell,* 264 U. S. 314, at 319:

> "Such an ordinary patent case with the usual issues of invention, breath of claims and noninfringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent."

The decisions of the Second and Sixth Circuit Courts of Appeals on the one hand, and the Seventh Circuit Court of Appeals on the other hand, do not have to be reconciled. As pointed out above, there is much *new material evidence* in the instant case which was not before the Second and Sixth Circuit Courts of Appeals, and it was because of that fact, among others, that the District Court and the Seventh Circuit Court of Appeals held the Gans claims invalid for want of invention.

It is submitted, therefore, that the petition for writ of certiorari to the Circuit Court of Appeals for the Seventh Circuit should be denied.

Respectfully submitted,

GEORGE L. WILKINSON,
CHARLES L. BYRON,
Counsel for Respondent.

NOTICE OF PRESENTATION OF RESPONDENT'S BRIEF.

Please take notice that the foregoing brief in behalf of Respondent is about to be filed with the Clerk of the Supreme Court of the United States, in the City of Washington, D. C.

Dated, ~~January~~ February 7th, 1931.

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Counsel for Respondent.

To:

Due and timely service of copies of Respondent's brief in opposition to the petition for writ of certiorari, is hereby acknowledged the ..... day of ~~January~~ February, 1931.

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Counsel for Petitioner.